

REMARKS

Applicant, by the amendments presented above, has made a concerted effort to present claims which more clearly define over the prior art of record, and thus to place this case in condition for allowance. Currently, claims 1-59 are pending and claims 1-18 have been examined.

Priority Claim

The Examiner objected to the priority claim and stated that none of the certified copies of the priority documents have been received.

Applicant submits that the certified copy of NZ504439 dated May 10, 2000 was filed in the parent application Serial No. 09/850,797, now United States Patent No. 6,769,431, on May 5, 2003 and was accepted by the Examiner in the Notice of Allowance on June 17, 2003.

With regard to NZ509041, the filing date of NZ509041 listed for the priority claim, December 20, 2001, was inadvertently listed on the Declaration and Power of Attorney and on the Applicant Data Sheet in the parent application and the present application, as a result of a typographical error. Applicant now notes that it should have been listed as December 20, 2000 (obviously since the parent application was filed on May 8, 2001) on the Declaration and Power of Attorney and on the Applicant Data Sheet.

The Certified Copy of NZ509041 having a filing date of December 20, 2000 was filed on May 5, 2003 in the parent application. In order to reinstate the priority claim and to advance the prosecution of this application, Applicant concurrently files a Petition to Accept Unintentionally Delayed Priority Claim Under 37 C.F.R. §1.55(c) and requests that same be granted (Applicant advises the Examiner that this does not impact the validity of the request for correction in the parent application with regard to this issue). Applicant requests to be

advised if a new certified copy of NZ509041 must be filed in this application to complete the priority claim.

Specification Objection

The specification was objected to because of the use of trademarks in the application. Applicant submits that this issue was resolved in the Preliminary Amendment submitted on September 15, 2003. If further amendments need to be made, Applicant respectfully requests that the Examiner suggest language.

Double Patenting

Claims 1-18 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of United States Patent No. 6,769,431 to Smith in view of United States Patent No. 6,523,538 to Wikefeldt. Applicant has concurrently filed a Terminal Disclaimer with regard to United States Patent No. 6,769,431 to Smith. Entry and acceptance of same is requested.

Claim Rejections - 35 U.S.C. §112

Claims 1-18 were rejected under 35 U.S.C. §112, first paragraph. In claim 1, the Examiner alleges that “a water vapour path from said exhalation flow passage to ambient air through said material” does not have a fully supporting disclosure such that one of ordinary skill in the art would understand the metes and bounds of the claimed invention. More specifically, although the language of claim 1 cited by the Examiner is also provided in the description, the Examiner finds that, there is no support articulated in the disclosure to describe the “flow path” or the “passage to ambient air.”

Throughout the specification, reference is made to the walls of the flow passage being made of a “breathable” material. See for example, the description of the embodiment illustrated in Figure 1, provided on page 5, lines 8-11 which provides that “the conduit 4 of the expiratory limb of a breathing circuit is formed having one or more longitudinal strips 2, 3 of breathable membrane as part of the wall 1 thereof.” The description at page 18, line 1-3, provides that the purpose of the breathable regions of the conduit wall is “. . . to allow diffusion of water vapour from the expiratory limb of the breathing circuit . . .” In addition to the descriptions of the wall as “breathable”, several suitable breathable materials are identified in the specification. These breathable materials from which the wall of the exhalation flow passage is formed are known, and the mechanisms by which these materials are able to transmit water vapor while not transmitting liquid water, are well understood by one of ordinary skill in the art. In order for a breathable material to “breathe”, it is inherently necessary for a water vapour flow path to exist, and the existence of a water vapor flow path would be instantly recognized by one of ordinary skill in the art when presented with the description of a product manufactured from a “breathable material”, in the specification. Thus, one of ordinary skill in the art, when presented with the application, would no doubt understand that the very nature of the breathable material requires that the material provides a water vapour flow path therethrough. “If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification the adequate written description requirement is met.” *In re Hershcler*, 591 F.2d 692, 200 USPQ 711 (CCPA 1979).

Therefore, Applicant submits that the present application provides a fully supporting disclosure such that one of ordinary skill in the art would understand the metes and bounds of

the claimed invention. Because a person of ordinary skill in the art would understand that Applicant possessed the claimed invention, Applicant's specification meets the requirements of 35 U.S.C. § 112. Thus, Applicant requests that the rejection be withdrawn.

Applicant notes that on page 5 of the Office Action, the Examiner has found that the original disclosure of the parent application Serial No. 09/850,797 (United States Patent No. 6,769,431) does not provide support for the recitation "a water vapour flow path from said exhalation flow passage to ambient air through said material" as presented in claim 1 was not supported. Therefore, the Examiner has advised that the prior art applied to the claimed subject matter is based upon the filing date of July 18, 2003 (the filing date of the divisional application), not the filing date of the parent application of May 8, 2001. Applicant submits that the original disclosure provides a fully supporting disclosure and therefore, the filing date of the parent application is the correct measure.

Claim Rejections - 35 U.S.C. §102

Claims 1-3 and 5-7 under 35 U.S.C. §102(a) and/or 102(e) as allegedly being anticipated by United States Patent No. 6,523,538 to Wikefeldt. Reconsideration and withdrawal of this rejection is requested.

Applicant submits that the term "breathing circuit **limb**" has an established meaning in the art and is restricted to the inspiratory tubing and/or expiratory tubing. The term "limb" is understood by one of ordinary skill in the art to exclude further breathing circuit components, installed in series or parallel, between the inspiratory limb and the expiratory limb, such as an in-line medical dryer as is disclosed in Wikefeldt. Applicant notes that throughout the specification of Wikefeldt, the distinction between an inspiratory limb, an

expiratory limb, and components such as the dryer and CO₂ absorber is acknowledged and maintained. (column 1, lines 31-34; column 2, line 41; column 3, lines 20-24).

In this regard, claim 1 has been amended to further clarify that the claims are intended to be limited to an exhalation limb of a breathing circuit, as distinguished from in-line medical dryers, such as that disclosed in Wikefeldt.

Therefore, Applicant submits that claim 1 is allowable over Wikefeldt.

Reconsideration and allowance of amended claim 1 is requested.

Claims 2-3 and 5-7 are dependent upon claim 1 which Applicant submits is condition for allowance. Reconsideration and allowance of claims 2-3 and 5-7 is requested.

Claim Rejections - 35 U.S.C. §103

Claim 4 was rejected under 35 U.S.C. §103 as allegedly being unpatentable over Wikefeldt in view of United States Patent No. 3,735,558 to Skarstrom et al. Claim 4 is dependent upon claim 1 which Applicant submits is condition for allowance.

Reconsideration and allowance of claim 4 is requested.

Claims 8 and 9 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Wikefeldt in view of United States Patent No. 5,233,996 to Coleman et al. Claims 8 and 9 are dependent upon claim 1 which Applicant submits is condition for allowance.

Reconsideration and allowance of claims 8 and 9 is requested.

Claims 8, 9 and 13 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Wikefeldt in view of published United States application No. US 2003/0070680 to Smith. Claims 8, 9 and 13 are dependent upon claim 1 which Applicant submits is condition for allowance. Reconsideration and allowance of claims 8, 9 and 13 is requested. In addition, 2003/0070680 to Smith has a filing date which is after the filing date of

the parent application. Because Applicant submits that the specification fully supports the claimed subject matter such that filing date of the parent application should be applied, Applicant submits that this is not a prior art reference.


Claims 8-12 and 14-18 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Wikefeldt in view of United States Patent No. 4,337,800 to Carlson. Claims 8-12 and 14-18 are dependent upon claim 1 which Applicant submits is condition for allowance. Reconsideration and allowance of claims 8-12 and 14-18 is requested.

A Petition for a One-Month Extension of Time is concurrently submitted herewith to extend the date for response up to and including February 19, 2005.

In view of the above Amendments and Remarks, Applicant respectfully submits that the claims of the application are allowable over the rejections of the Examiner. Should the Examiner have any questions regarding this Amendment, the Examiner is invited to contact one of the undersigned attorneys at (312) 704-1890.

Respectfully submitted,

Dated: Feb. 17, 2005

By: 
Raiford A. Blackstone, Jr., Reg. No. 25,156
Linda L. Palomar, Reg. No. 37,903

TREXLER, BUSHNELL, GIANGIORGI
BLACKSTONE & MARR, LTD.
105 W. Adams Street
Suite 3600
Chicago, Illinois 60603
(312) 704-1890